

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: <b>Ferri et al.</b>	§	Group Art Unit: <b>2174</b>
	§	
Serial No. <b>10/730,957</b>	§	Examiner: <b>Muhebbullah, Sajeda</b>
	§	
Filed: <b>December 9, 2003</b>	§	Confirmation No.: <b>3686</b>
	§	
For: <b>Database Script Translation Tool</b>	§	Attorney Docket No.: <b>AUS920030843US1</b>
	§	

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PATENT TRADEMARK OFFICE  
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**REPLY BRIEF (37 C.F.R. 41.41)**

This Reply Brief is submitted in response to the Examiner's Answer mailed on August 19, 2008.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

This brief does NOT replace the Appeal Brief dated May 29, 2008. Rather, this brief extends the arguments of the Appeal Brief and responds to the arguments raised by the Examiner's Answer. This brief contains items under the following headings as suggested by M.P.E.P § 12081:

- I. STATUS OF CLAIMS
- I. INTRODUCTION
- II. LAW APPLICABLE TO THE REPLY
- III. REMARKS/ARGUMENTS

## **RESPONSE TO EXAMINER'S ANSWER**

### **I. STATUS OF CLAIMS**

A. Total Number of Claims in Application: 48

B. Current Status of Claims:

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-48
4. Claims allowed: None
5. Claims rejected: 1-48

C. Claims on Appeal: 1-48

### **II. INTRODUCTION**

In Section 9 of his answer, the Examiner repeats the arguments set forth in the Final Office Action (Examiner's Answer, pages 3-8). In section 10 of his answer, the Examiner responds to the Arguments made by Appellants in their Appeal Brief. Therefore, this Reply Brief responds to section 10 only, and does not replace Appellants' Amended Appeal Brief. The Reply Brief is organized by each of the new arguments made by the Examiner in his answer and are indicated by numerals I through VII. In addition, the claims relevant to the Examiner's new argument are indicated in each section. A "Law Applicable to the Reply" precedes the discussion to minimize repetition of the cited material.

### **III. LAW APPLICABLE TO THE REPLY**

As will be explained in detail below, Appellants submit that the Examiner has not demonstrated that the limitations are expressly disclosed in the cited art. Nor has the Examiner argued that the limitations are inherently disclosed. Appellants submit that the limitations are not inherently disclosed because the Examiner has not and cannot meet the standard for establishing inherency.

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999.) “Inherency, however, may not be established by probabilities or possibilities” and “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

Appellants argue below that the Examiner has not shown the elements to be expressly disclosed and that the elements cannot be shown to be inherently disclosed because the cited art does not make clear, “that the missing descriptive matter is necessarily present in the thing described” (*Id.*) and that showing that the elements that are not expressly disclosed are possibly disclosed in the cited art is impermissible (*Id.*).

#### **IV. REMARKS/ARGUMENTS**

The Examiner states that Appellants argue that “Bolnick does not discuss organizing icons within a desktop segment by resizing the icons within the segment.” (Answer, page 8). The Examiner disagrees because, “it is noted that the features upon which the applicant relies (i.e., resizing the icons) are not recited in the rejected claim(s)” and limitations from the specification are not read into the claims.

##### **Claim 1**

The Examiner statement that “the features upon which the applicant relies ... are not recited in the rejected claim(s)” is incorrect because rejected claim 4 and rejected claim 5 specifically recite sizing limitations. Moreover, claim 1 uses a defined term (“organize”). “Organize” is defined in the specification, paragraph [0026] to mean “arranging a plurality of icons in a specific manner.” Bolnick’s sorting of icons does not meet claim 1’s requirement of “organizing the icons” because Bolnick does not organize the icons in a “specific manner.” For at least this reason, Bolnick does not anticipate claim 1. Moreover, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that the elements that are not expressly disclosed are possibly disclosed in the

cited art is impermissible.

#### **Claim 4**

Claim 4 recites “wherein the organization of the icons is to shrink the icons down to the icons smallest size.” In the Examiner’s Answer, the Examiner cites Bolnick, col. 31, lines 28-40 as teaching the method of claim 4. However, the cited portion of Bolnick does not discuss resizing icons to smallest size possible, but rather discusses only that the Windows GUI allows icons to be resized. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

#### **Claim 5**

Claim 5 recites “wherein the organization of the icons is to change the size of the icons such that the icons fill the segment.” In the Examiner’s Answer, the Examiner cites Bolnick, col. 31, lines 28-40, and Scott, col. 16, lines 17-23 as teaching the method of claim 5. The cited portion of Bolnick has been discussed above. Scott does not remedy the deficiency of Bolnick because increasing the size of icons to fill a browser window, as taught by Scott, is not the same as increasing the size of icons to fill a desktop segment because the browser window is not a user-defined area on the desktop. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

## **II**

#### **Claim 1**

The Examiner states that Appellants argue that “Bolnick’s method is complicated and requires many steps whereas Appellants’ invention provides for organizing icons on a desktop by only making selections from a menu and activating a submit control therefore requiring fewer use actions.” (Answer, page 8). The Examiner states that Bolnick teaches the invention as claimed

“wherein the only user actions required to automatically organize the plurality of icons on the computer desktop are for a user to make a plurality of user selections at the define segments menu and to activate the submit control (col. 21, lines 38-49, selection of a menu item is equivalent to submission control).” The Examiner then states that Appellants’, “invention claims making a plurality of selections as taught by Bolnick.”

Bolnick discloses a Global Cleanup Operation that is initiated by a user by selecting a corresponding menu selection on the Desktop graphical user interface. (Bolnick col. 21, lines 38-39). The Global Cleanup Operation assigns repositionable desktop items to proper frames in accordance with space available within the frames. (Bolnick, col. 21, lines 40-41). Appellants submit that Bolnick does not expressly disclose the limitation of organizing (arranging a plurality of icons in a specific manner) by making selections from a menu and activating a submit control. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

### **III**

#### **Claim 4**

The Examiner states that Appellants argue that “Bolnick does not discuss resizing icons to smallest size possible.” The Examiner states that Bolnick teaches the icons to be displayed in a small view and to be able to resize the icons and maintain the smallest size possible. (Bolnick, col. 31, lines 28-50). Bolnick discloses only that icons can be resized. But Bolnick is silent as to “resizing icons to the smallest size possible.” Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

### **IV**

#### **Claim 5**

The Examiner states that Appellants argue that “[a] browser window, as taught by Scott,

does not provide the same functionality of a desktop, and therefore, increasing the size of icons in a browser window does not have the same advantages as increasing the size of icons in a desktop segment.” The Examiner argues that Appellants are attacking the reference individually and the Examiner combines Scott to teach the method of changing the size of icons to fill a segment whereas Bolnick teaches the limitation of a desktop segment. Scott discloses a process of compressing and scaling thumbnails. Scott states that “thumbnails preferably fill a display window when displayed and do not unnecessarily leave significant portions of a display window unused.” (Scott, col. 16, lines 17-23). Thus, the combination of Scott and Bolnick does not expressly disclose the limitation. Indeed, the combination of Scott and Bolnick merely raises a possibility that the limitation might be disclosed. Neither Scott nor Bolnick, individually or in combination, expressly disclose the limitation. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

## V

### **Claim 6**

The Examiner states that Appellants argue that “Scott only discusses increasing and decreasing icon size to fill a window, and does not at all discuss having the icons default to normal size and then shrinking them if necessary.” The Examiner argues that Appellants are attacking the reference individually, and the Examiner combines Scott to teach the method of changing the size of icons to fill a segment whereas the limitation of viewing icons in normal size is taught by Bolnick.

Scott discloses a process of compressing and scaling thumbnails. Scott states that “thumbnails preferably fill a display window when displayed and do not unnecessarily leave significant portions of a display window unused.” (Scott, col. 16, lines 17-23). Thus, the combination of Scott and Bolnick do not expressly disclose the limitation. Indeed, the combination of Scott and Bolnick merely raises a possibility that the limitation might be disclosed. Neither Scott nor Bolnick, individually or in combination, expressly disclose the limitation. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to

be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

## **VI**

### **Claim 7**

Scott does not teach adding scroll bars to a desktop segment. The Examiner argues that Appellants are attacking the reference individually, and the Examiner combines Scott to teach the method of adding scroll bars whereas the limitation of the desktop segment is taught by Bolnick. Scott merely mentions scroll bars in the “Background of the Invention” section of the patent to discuss the disadvantages of using scroll bars--“user disorientation” and “making navigation of an image space difficult.” (Scott, col. 1, lines 57-58 and 63). Thus, the combination of Scott and Bolnick does not expressly disclose the limitation. Indeed, the combination of Scott and Bolnick merely raises a possibility that the limitation might be disclosed. Neither Scott nor Bolnick, individually or in combination, expressly disclose the limitation. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and because showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

## **VII**

### **Claims 8 and 9**

Neither of the cited portions of Nason discusses anything about wallpaper on a desktop, much less defining segments of the desktop according to whether the segments cover wall paper on the desktop” and “Nason is concerned with the area outside of the desktop, whereas claim 8 is concerned with the area within the desktop and whether segments in that area cover wallpaper on the desktop.” The Examiner argues that Appellants are attacking the reference individually. The Examiner stated that “Nason teaches the display of a desktop containing a default wall paper (Fig. 33, 3301)” and that “[a]nything displayed within the computer screen is considered an onscreen work areas a.k.a. desktop therefore Nason is concerned with the areas within the desktop and displays segments that do not cover the wallpaper (FIG. 33).”

The word wallpaper does not appear in Scott. The Examiner relies only on an inference from the single drawing item. Indeed, item 3301 is identified in Nason as “display area 3301” or native “desktop 3301.” Therefore, Nason is completely silent as to “wallpaper.” Thus Nason alone, or in combination with Bolnick and/or Scott, does not expressly disclose the limitation. Indeed, Nason merely raises a possibility that the limitation might be disclosed. Therefore, the Examiner has not shown the element to be expressly disclosed and the elements cannot be shown to be inherently disclosed because the cited art does not make clear that the missing descriptive matter is necessarily present in the thing described and that showing that elements not expressly disclosed are possibly disclosed in the cited art is impermissible.

### **CONCLUSION**

For the reasons set forth above and for the reasons set forth in Appellants’ Reply Brief, Appellants request that the rejection of the claims be reversed.

Respectfully submitted,

/Rudolf O. Siegesmund/

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